Regarding independent claims 1 and 10, the Office Action admits that Borg does not disclose that the first color and the second color are be included in the overmarked pixels in the same raster image, as claimed in claims 1 and 10. However, the Office Action asserts that Borg discloses all other claimed features of claims 1 and 10. The Office Action's assertion is incorrect.

First, Borg fails to disclose, teach or suggest the recited feature of generating information that designates the overmarked pixels, as claimed in claims 1 and 10. Further, Borg fails to disclose, teach or suggest the recited feature of modifying image data of the overmarked pixels in the raster image, as claimed in claims 1 and 10.

The Office Action, at page 2, asserts that Borg, in Figs. 1 and 2, discloses means for (110 in Fig. 1) or steps of (items 200, 205 in Fig. 2) performing this function. Applicants respectfully disagree with this assertion.

Borg is completely silent regarding the claimed features generating information that designates the overmarked pixels and modifying image data of the overmarked pixels in the raster image, as claimed in claims 1 and 10. Instead, Borg, at col. 1, lines 44-60, is directed to a process of blending two or more colors (200 and 205 in Fig. 2) in a PDF file (110 in Fig. 1) using a raster image processor in order to conserve local computer resources, allow graphical objects to remain device independent and allow users to obtain blended graphical output without modifying their graphical processing flows. Nowhere in Borg there is disclosed, taught or suggested generating information that designates the overmarked pixels or modifying image data of the overmarked pixels in the raster image, as claimed in claims 1 and 10.

In fact, Borg has nothing to do with processing a color image containing overmarked pixels, but instead is concerned with processing page description language (PDL) files so that an output can be optimized for a specific output device.

Second, while Borg may arguably teach a raster image processor that blends the images in accordance with a specified blending mode, Applicants respectfully submit that Borg fails to explicitly teach or suggest that the first color and the second color are be included in the overmarked pixels in the same raster image, as claimed in claims 1 and 10.

The Office Action, at page 3, asserts that it "would have been obvious to one skilled in the art at the time the invention was made to consider the raster image processor in Borg et al. output a raster image that allows both the at least one first color and the second color to be includes [sic] since the raster image processor produces a blended image which includes a combination of the foreground and background colors."

Applicants disagree with this assertion. As required by MPEP Section 706.02(j), to establish a prima facie case of obviousness, these basic criteria must be met:

1) There must be some suggestion or motivation in the references themselves or in the knowledge generally available;

2) Reasonable expectation of success;

3) The prior art reference must teach or suggest all claim limitations.

The first and third requirements have not been met by the rejections of the Office Action. Borg does not show any motivation to modify its structure to achieve the claimed invention, and the Office Action clearly admits that there is an essential part of the claimed invention missing in Borg.

Thus, Applicants respectfully submit that Borg does not teach or suggest the claimed invention as claimed in independent claims 1 and 10.

For at least these reasons, it is respectfully submitted that independent claims 1 and 10 are distinguishable over the applied art. Claims 19-22, which depend from claims 1 or 10, are likewise distinguishable over the applied art for at least the reasons discussed above as well as for the additional features they recite.

Regarding claims 2-5 and 11-14, Applicants submit that Borg fails to teach or suggest a method or an apparatus for processing image data including, <u>inter alia</u>, modifying the image data of the overmarked pixels in the raster image so that a reduced amount of marking material corresponding to the at least one first color is being applied to a marking substrate, as claimed in claims 5 and 14.

As discussed above, Borg has nothing to do with processing a color image containing <u>overmarked</u> pixels, but instead is concerned with processing page description language (PDL) files so that an output can be optimized for a specific output device. Thus, Borg is silent regarding any processing steps or devices used to process a color image containing <u>overmarked</u> pixels in order to apply a reduced amount of marking material of at least one first color to a marking substrate.

Thus, Applicants respectfully submit that Borg does not teach or suggest the claimed invention as claimed in claims 2-5 and 11-14.

For at least these reasons, it is respectfully submitted that claims 2-5 and 11-14 are distinguishable over the applied art.

Regarding claims 6-9 and 15-18, the Office Action, at page 4, admits that Borg fails to teach the claimed invention, as claimed in claims 6-9 and 15-18. Specifically, the Office action admits that Borg fails to teach means for or steps of generating tags that correspond to the overmarked pixels, as claimed in claims 6 and 15. Further, the Office Action admits that Borg fails to teach that the overmarked pixels correspond to a black image and the tags indicate that the overmarked pixels are black image pixel, as claimed in claims 7 and 16. Further, the Office Action admits that Borg fails to teach that the overmarked pixels correspond to one of black text and a black stroke, and the tags indicate that the overmarked pixels are one of black text pixels and black stroke pixels, as claimed in claims 8 and 17. Further, the Office Action admits that Borg fails to teach the feature of performing pattern

-4-

recognition that recognizes specified patterns, as claimed in claim 9, or a pattern recognition device that recognizes specified patterns and designates pixels that form the recognized patterns as the overmarked pixels, as claimed in claim 18.

However, the Office Action asserts that Shaughnessy makes up for the deficiencies of Borg. Applicants respectfully disagree with this assertion.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive to do so. In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). None of the cited references teaches, suggests or renders obvious all of the features recited in claims 6-9 and 15-18.

The Office Action impermissibly uses hindsight reconstruction to pick and choose among isolated disclosures in the prior art to allege that the Applicants' claimed invention is rendered obvious. However, as described above, the references taken in combination fail to teach, suggest or render obvious all of the features recited in claims 6-9 and 15-18.

For at least these reasons, the Office Action has not established a prima facie case of obviousness, as the applied references fail to teach or suggest all of the subject matter of claims 6-9 and 15-18. It is respectfully submitted that claims 6-9 and 15-18 are distinguishable over the applied art.
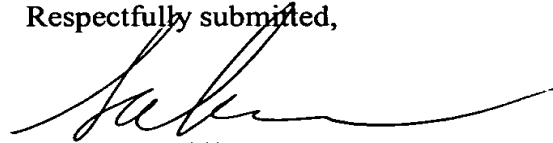
Withdrawal of the rejections under 35 U.S.C. §103 is respectfully requested.

II.   **Conclusion**

For at least the reasons discussed above, it is respectfully submitted that this application is in condition for allowance.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

George P. Simion
Registration No. 47,089

JAO:GPS/hs

Date: November 29, 2002

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE
AUTHORIZATION
Please grant any extension
necessary for entry;
Charge any fee due to our
Deposit Account No. 24-0037